

REMARKS

The present patent application has been reviewed in light of the office action, dated November 15, 2005, in which claims 18-27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-19, 21, 24, and 26 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Assignee regards as the invention. Claims 18-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagoshi et al., U.S. Patent No. 6,164,745 (hereinafter “Nagoshi”).

Claims 18-33 are pending in the application. Claims 18-19, 21, and 23-26 have been amended. New claims 28-33 have been added. The amendments are fully supported by the original disclosure. No new matter has been introduced. The above amendments were made to clarify Assignee’s claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

Rejections under 35 U.S.C. § 101

Claims 18-27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. However, Assignee respectfully submits that the claimed subject matter includes more than an apparatus that “merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application in the technological arts” as asserted by the Examiner. For example, the claimed subject matter, fully supported by the original disclosure, includes scanning and calibration operations which clearly have practical applications in the technological arts. Therefore,

Assignee respectfully contends that the claimed subject matter is directed to statutory subject matter, and the rejection is traversed.

Rejections under 35 U.S.C. § 112

Claims 18-19, 21, 24, and 26 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Assignee regards as the invention. Clarifying amendments have been made to claims 18-19, 21, 24, and 26, and therefore the rejection is respectfully traversed.

Rejections under 35 U.S.C. § 103(a)

Claims 18-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagoshi. In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

As admitted by the Examiner, Nagoshi does not disclose a “scanning a calibration chart” as claimed in claims 18-27. Further, there would be no motivation to use a calibration chart with the teachings of Nagoshi because to do so would frustrate the purposes of Nagoshi and would render the embodiments disclosed in Nagoshi inoperable. Nagoshi involves printing and scanning test patterns to evaluate printing operations (see, for example, Nagoshi, column 14 lines 29-45) while the claimed subject matter of the present application involves scanning a calibration chart to evaluate scanning operations. Use of a calibration chart would bypass the

test print operations of Nagoshi, thereby rendering the embodiments of Nagoshi inoperable.

For at least these reasons, claims 18-24 patentably distinguish over the cited patent.

It is noted that claimed subject matter may be patentably distinguished from the cited patent for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he or she is invited to contact the undersigned at (503) 439-6500. Reconsideration of the present patent application and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

Dated: 3/14/06

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